

### Remarks/Arguments

This is responsive to the Office Action mailed October 18, 2005. The amendments are proper, serve to more particularly point out and distinctly claim that which is patentable over the references of record, do not introduce new matter, do not require additional searching, and are broadening and thus not narrowing in view of a prior art rejection.

### Claim Objections

Claims 9-17 were objected to for containing the term "step" as follows: "these claims contain a term "step" in the apparatus claims which are restricted with a special patent terminology." (Office Action of 10/18/2005, pg. 2)

To the extent the objection is understood, Applicant traverses it because independent claim 9 is properly in the form of a "steps-for" claim as permitted by 35 USC 112 paragraph six. This statutory authority requires that the claim be drawn to a combination, and that the "steps-for" element not explicitly recite acts in support of the recited function. Applicant respectfully submits that the language of claim 9 meets all these statutory requirements, such that construing the claim in accordance with Section 112 para. 6 obviates the Examiner's objection. Withdrawal of the objection is respectfully requested.

### Rejection Under 35 USC 112 Second Paragraph

Claims 3 and 12 were rejected as being indefinite for lacking the term "track" after the recited "first information." Claim 3 has been canceled and claim 12 has been amended to obviate this rejection. Reconsideration and withdrawal of the rejection are respectfully requested.

### Rejection Under 35 USC 102

Claims 1-17 were rejected as being anticipated by Forehand '738. This rejection is respectfully traversed.

#### Claim 1

Forehand '738 cannot sustain a prima facie case of anticipation because it does not identically disclose all the features of the present invention as claimed in claim 1, including at least the following:

*moving the read/write head while substantially at the maximum fly height to a beginning position...and executing a move cycle routine moving the read/write head away from the beginning position while remaining substantially at the minimum fly height.*  
(excerpt from claim 1, emphasis added)

The embodiments of the present invention as claimed employ adaptive fly height control which is advantageous, for example, in reducing wear otherwise resulting from contacting engagements between the head and the disc during execution of debris sweep cycles. Forehand '738 does not identically disclose *moving the read/write head while substantially at the maximum fly height to a beginning position...and executing a move cycle routine moving the read/write head away from the beginning position while remaining substantially at the minimum fly height* as in the present embodiments as claimed.

Forehand '738 does disclose that the fly height can vary for reasons other than the adaptive fly height control of the present embodiments as claimed. For example, Forehand '738 observes that the fly height will be relatively greater over the smooth surface of the data zone as compared to the textured landing surface. (see, for example, Forehand '738, col. 3 lines 17-26) For another example, Forehand '738 observes that the fly height will be

relatively proportional to the radial location of the head in the data zone. (see, for example, Forehand '738, col. 4 lines 59-62)

Again, however, Forehand '738 does not identically disclose *moving the read/write head while at the maximum fly height to a beginning position...and executing a move cycle routine moving the read/write head away from the beginning position while remaining at the minimum fly height*. Accordingly, Forehand '738 cannot sustain a prima facie case of anticipation because it does not identically disclose all the features of the embodiments of the present invention as claimed in claim 1. Reconsideration and withdrawal of the present rejection of claim 1 and the claims depending therefrom are respectfully requested.

#### Claim 9

As explained above, Forehand '738 cannot sustain a prima facie case of anticipation because it does not identically disclose the recited feature "*steps for associating...*"

Claim 9 is written in accordance with 35 U.S.C. §112, sixth paragraph. The Applicant has identified the function associated with the recited "steps for" element as being associating the fly height with the radial direction of the transducer, such as during sweep cycles clearing debris. The Examiner is obliged as a matter of law to construe this steps-for element as the disclosed acts, and equivalents thereof, that are capable of the identical function. See *B. Braun Medical, Inc. v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997); *In re Donaldson Co. Inc.*, 26 USPQ2d 1845 (Fed. Cir. 1994)(*en banc*); *In re Dossel*, 42 USPQ2d 1881 (Fed. Cir. 1997); *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, Para. 6*, 65 FR 38510. Failure to do so constitutes reversible error.

The present rejection is the result of an incomplete examination because the Examiner did not construe claim 9 in accordance with Section 112 paragraph six. 37 CFR 1.104(a). The fact that the Examiner did not properly construe the steps-for claim is grounds in and of itself for withdrawal of the rejection, and grounds that the next action cannot be made final as it will be the first action on the merits for claim 9.

For reasons explained above for claim 1, Forehand '738 does not identically disclose the recited *means for associating*.... Accordingly, the Examiner has failed to substantiate the requisite prima facie case of anticipation because Forehand '738 does not identically disclose all the features of the embodiments of the present invention as claimed in claim 9. The present rejection of claim 9 is erroneous and therefore reversible as a matter of law. Reconsideration and withdrawal of the present rejection of claim 9 and the claims depending therefrom are respectfully requested.

#### New Claims

New independent claim 18 more particularly points out and distinctly claims the patentable subject matter of the present embodiments. Claim 18 is patentable over the art of record which does not identically disclose all the features of the present invention as claimed in claim 18, including at least the following:

*An apparatus comprising circuitry configured to spatially separate a transducer from a storage medium by a first separation that is greater than a nominal data transfer separation, to thereafter move the transducer adjacent a selected portion of the storage medium at the first separation, to thereafter lower the transducer to a second separation that is less than the nominal data transfer separation, and to thereafter move the transducer across the storage medium at the second separation.*

(claim 18, emphasis added)

As explained above for claim 1, the embodiments of the present invention as claimed employ adaptive fly height control, such as to reduce wear otherwise resulting from contacting engagements between the head and the disc during execution of debris sweep cycles. Particularly, some embodiments first move the transducer while *at the first separation* to a starting position for a sweep cycle, and then perform the sweep cycle with the transducer remaining *at the second separation*.

The art of record does not identically disclose *to thereafter move the transducer adjacent a selected portion of the storage medium at the first separation... to thereafter move the transducer across the storage medium at the second separation* as in the present embodiments as claimed.

Since the art of record fails to identically disclose these features, a prima facie case of anticipation cannot be substantiated under Section 102. The Applicant respectfully submits that there is nothing in the art to cure this deficiency with regard to substantiating a prima facie case of obviousness under Section 103. There is no suggestion or motivation, neither in the cited art nor within the knowledge of the skilled artisan, to modify the references or to combine references to arrive at the subject matter of claim 18. On these bases the Applicant respectfully submits that the subject matter of claim 18 and the claims depending therefrom are patentable.

### Conclusion

This is a complete response to the Office Action mailed October 18, 2005. The Applicant requests reconsideration and withdrawal of all rejections.

The Applicant has also included herewith a request for telephone interview to clarify the unresolved issues concerning the proper construction of claim 9 under Section 112 paragraph six, and the lack of the requisite prima facie case of anticipation for the claims as originally filed.

The Examiner is invited to contact the Attorneys listed below should any questions arise concerning this response or request for interview.

Respectfully submitted,

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